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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,906	11/01/1999	JAMES PAUL WEST	PW-1	7934

29847 7590 06/18/2003

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EXAMINER

SHERRER, CURTIS EDWARD

ART UNIT PAPER NUMBER

1761

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DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/430,906

Applicant(s)

West et al.

Examiner

Curtis E. Sherrer

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1761

mk-2)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 24, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-16, 18-27, 29, and 31-37 is/are pending in the application.
- 4a) Of the above, claim(s) 18-20, 25-27, 31, 32, and 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-16, 21-24, 29, and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-16, 21-24, 29 and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added phrase "5 percent of ethanol or more" could not be found in the specification. See claim 1 and 21.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 8-12 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is indefinite because it expands rather than narrows the scope of claim 1, with respect to the amount of ethanol contained in the capsule.

Claims 8-10 are indefinite because it is unclear which range applicants intend to claim.

Claim 11 is still indefinite because it contains the term “about,” which was previously rejected as being indefinite.

Claims 11 and 12 indefinite because it expands rather than narrows the scope of claim 1, with respect to the volume contained in the capsule.

Claim 29 is indefinite because the scope of the phrase “appearance of an olive” is not known. Again, it is still not known what phrase encompasses with respect to size, color, etc. There are no drawings in the case that would provide some scope to the phrase.

Claim Rejections - 35 USC § 103

Claims 1, 4-16, 21, 22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brox (U.S. Pat. No. 4,888,239).

Brox teaches that cited in previous Office actions. While Brox does not teach a specific size it is stated that the “capsules are commonly sized and shaped so as to be readily swallowable by a person, usually with the aid of water.” (Col. 3, lines 17-19). It would have been obvious to those of ordinary skill in the art to modify the size of Brox’s capsule so as deliver the necessary quantity of ingredients to the consumer. Further, case law holds that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. *Gardner v. TEC*

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Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984) *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

Claims 1, 4-16, 21, 22, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanker *et al.* (U.S. Pat. No. 5,620,707)(hereinafter "Sanker") in light of Handbook of Perfumes and Flavors (page 280).

Sanker teaches that cited in previous Office actions. While Sanker does not teach the size now claimed it would have been obvious to those of ordinary skill in the art to modify the size of Sanker's capsule so as deliver the necessary quantity of ingredients to the consumer. Again, see *Gardner*.

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanker in view of McMahon *et al.* (U.S. Pat. No. 5,466,460)(hereinafter "McMahon") for the reasons set forth in the last Office Action.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Curtis E. Sherrer', with a long horizontal flourish extending to the right.

Curtis E. Sherrer
Primary Examiner
June 13, 2003